



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/816,710	04/02/2004	Yoshinari Higuchi	450100-05014	1185

7590 10/05/2010
William S. Frommer, Esq.
FROMMER LAWRENCE & HAUG LLP
745 Fifth Avenue
New York, NY 10151

EXAMINER

CHOWDHURY, NIGAR

ART UNIT	PAPER NUMBER
----------	--------------

2484

MAIL DATE	DELIVERY MODE
-----------	---------------

10/05/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/816,710	Applicant(s) HIGUCHI ET AL.	
	Examiner NIGAR CHOWDHURY	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/23/2010 has been entered.

Response to Arguments

Applicant's arguments with respect to claims 1, 4, 8 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,953,481 by Watanabe et al. in view of US 5,930,446 by Kanda

Art Unit: 2621

2. Regarding **claim 1**, Watanabe et al. discloses an imaging device configured to output imaging data that is obtained by imaging of an object, the imaging device comprising:

- Recording means for recording the imaging data on the recording device.
(fig. 2 (32));
- communication means for communicating the imaging data (fig. 3, 6 (111j)); and
- control means for recognizing a controlled state of an external recording device when a communication is enabled with the recording device through the communication means conforming to a predetermined transmission method (fig. 3 (2, 13), fig. 6 (115));
- wherein the control means is configured to transmit a start-up request for a recording application in response to the recognized control state of the external recording device (fig. 3, 6, col. 8 lines 60-col. 9 lines 12, col. 11 lines 27-34, col. 12 lines 33-59)
- wherein the control means is configured to transmit the imaging data to the external recording device through the communication means (fig. 3, 6, col. 8 lines 60-col. 9 lines 12, col. 11 lines 27-34, col. 12 lines 33-59)
- wherein the external recording device records the imaging data that has been obtained through the communication means based on the recording application executed (fig. 3, 6, col. 8 lines 60-col. 9 lines 12, col. 11 lines 27-34, col. 12 lines 33-59)

Watanabe et al. fails to disclose

- wherein the control means is configured to reproduce the imaging data in response to receiving a control command from the external recording device, and simultaneously transmit the imaging data to the external recording device through the communication means

Kanda discloses

- wherein the control means is configured to reproduce the imaging data in response to receiving a control command from the external recording device, and simultaneously transmit the imaging data to the external recording device through the communication means (fig. 1, col. 2 lines 35-45)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the proposed combination of Watanabe et al.'s system to include simultaneously recording and reproducing, as taught by Kanda, for having more flexibility to a user to watch a data while recording.

3. Regarding **claim 2**, Watanabe et al. discloses the imaging device further comprising display means for displaying the progress of an application needed for a recording operation obtained by controlling the recording device (fig. 5 (7), 7, col. 13 lines 13-60).

Art Unit: 2621

4. Regarding **claim 3**, Watanabe et al. discloses the imaging device wherein, when communications are enabled with a plurality of the recording devices through the communication means connected respectively to the recording devices, the control means selects the specific recording device as a communication target on the basis of unique node IDs assigned respectively to the communication means, and refuses to communicate with the other recording devices than the selected recording device (fig. 3 (1, 11), 6 (117, 120), col. 7 lines 66-67, col. 8 lines 60-col. 9 lines 12, col. 12 lines 5-6, 10-18).

5. **Claim 4** is rejected for the same reason as discussed in the corresponding claim 1 above.

6. **Claim 5** is rejected for the same reason as discussed in the corresponding claim 2 above.

7. **Claim 6** is rejected for the same reason as discussed in the corresponding claim 3 above.

8. **Claim 7** is rejected for the same reason as discussed in the corresponding claim 3 above.

9. **Claim 8** is rejected for the same reason as discussed in the corresponding claim 1 above.

10. Regarding **claim 9**, the imaging device wherein the communication means is connected outside of the imaging device (fig. 2 (212)).

Art Unit: 2621

11. **Claim 10** is rejected for the same reason as discussed in the corresponding claim 9 above.

12. **Claim 11** is rejected for the same reason as discussed in the corresponding claim 9 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NIGAR CHOWDHURY whose telephone number is (571)272-8890. The examiner can normally be reached on 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Application/Control Number: 10/816,710
Art Unit: 2621

Page 7

/Jamie J Atala /
Primary Examiner, Art Unit 2621